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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,882	02/09/2001	Jacques Benkoski	MDS-P009	9016

35273 7590 10/02/2006  
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EXAMINER

JANVIER, JEAN D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/780,882

Applicant(s)

BENKOSKI ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **Response To Applicant's Arguments**

Applicant's arguments with respect to the claimed invention have been considered but are moot in view of the new ground(s) of rejection.

### **DETAILED ACTION**

#### **Specification**

It appears that no drawing was filed along this Application.

The title of the invention should be descriptive and technically accurate. Furthermore, the abstract of the disclosure should be descriptive. See 37 CFR 1.72.

#### **Status of the claim**

Claims 26-40 are currently pending in the Application.

#### **Claims Objections**

Claims 28, 29 and 35 are objected to because of the following informalities.

Concerning claims 28 and 35, "...the trigger condition disables a set of features of the CAD tool" appears to be incomplete. Although it is clear that a piece of software (Tool) comprises a plurality of features (some of them may be enabled or disabled), nevertheless, it is rather unclear here why the "trigger condition" will disable a set of specific features thereof. In other words, some intervening steps are missing therefrom.

Concerning claim 29, in "wherein the set of features include at least one of generating a predetermined output file **and running another CAD**", although it is understood that the Tool

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features enable a user to generate an output, however, the "running another CAD" limitations appear to be unclear and do not further limit the claim.

Appropriate corrections.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, USP 6,594,799.

As per claims 26-40, Robertson discloses a multi-faceted portal site that acts as a server in the context of an n-tier client/server network and connects electronic designers and design teams to design and verification tool and service providers on the other through a single portal site. Tools and services accessible to users through the portal site include electronic design automation (EDA) software tools, electronic component information, electronic component databases of parts (or dynamic parts), computing and processing resources, virtual circuit blocks, design expert assistance, and integrated circuit fabrication (**providing a CAD Tool to a user via a network, where the user runs or executes the provided Tool on his computer system to**

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**produce an output or complete a project).** Such tools and services may be provided in whole or in part by suppliers (manufacturers) connected to the portal site. Users accessing the portal site are presented with options in a menu or other convenient format identifying the tools and services available and are able to more rapidly **complete circuit designs** by having access to a wide variety of tools and services in a single location. **The portal site may facilitate purchase, lease or other acquisition (which may include pay-per-use or pay by installment based on a contract or agreement) of the tools and services offered through it.** The portal site tracks the movements of users through the portal site in order to learn about the design preferences and design approaches of users individually and in the aggregate. Previous actions taken by a user and by similarly-situated users may be considered in determining which information is presented to the user or in what order to present information to the user, thereby providing contextually-driven access (See abstract; fig. 3-5 and 7-10; col. 1: 35-54; col. 2: 12-24; col. 2: 40-54; col. 4: 49-61; col. 4: 64 to col. 5: 28).

In general, the present system features electronic design tools and automation and more specifically methods and systems for facilitating electronic circuit and chip design using resources accessible over a distributed electronic network such as the Internet. The system is also adapted to allow users, such as design engineers, to use these tools without a large capital outlay in either software or hardware (a user of a

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design and verification tool does not need a huge up front cash to access or use the tool to produce an output-col. 1: 10-14; col. 4: 48-61).

In another embodiment, the portal site 104 connects end users 102 looking for information on virtual circuit blocks or IP cores, or interested in purchasing such, with suppliers 106 offering virtual circuit blocks or IP cores. The portal site 104 may facilitate the locating and acquisition of suitable virtual circuit blocks or IP cores by, for example, providing a catalog of available IP cores, information regarding the IP cores, and access to mechanisms for protecting IP cores from unauthorized user or copying (col. 7: 11-19).

Further, in a next step 624 of fig. 6, a purchasing routine is preferably invoked during which the selected IP core (virtual block design or CAD Tool) is purchased (receiving a payment for the purchase of the Tool). In a following step 626, the selected and purchased IP core is delivered to the user, preferably in electronic format over the Internet 230. As a part of step 626, the portal site 204 preferably performs a protection function where the IP core is protected from piracy or unauthorized use by embedding each IP core transmitted via the portal site with a digital (One type of digital watermarking technique that may be used is disclose, for example, in copending U.S. patent application Ser. No. 09/514,695 filed concurrently herewith, and hereby incorporated by reference as if set forth fully herein. Alternatively, a digital watermark may simply comprise an embedded code (such as an encoded/encrypted identifier or set of identifiers or a non-functional data) physically included as part of the IP core software (col. 18: 41-58).

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The present system further comprising means for transmitting an electronic invoice from said selected provider or supplier of the (CAD) tool or service to the user's system over a distributed electronic network and remitting a transaction fee from the provider to said portal site for facilitating the transaction, such as the receipt acquisition of the tool or IP core from the supplier to the user's system via the portal site over the Internet, and means for receiving payment for said electronic invoice from said user, means for deducting the transaction fee from said payment at said portal site and means for remitting the remainder of said payment to said selected provider of the tool (integrated circuit fabrication services- See claims 10 and 11 of the current reference).

Finally, it is herein understood that one skilled in the art or a software, a CAD (AutoCAD) or a spreadsheet user familiar with the software, the CAD or the spreadsheet can identify an output as having been produced with the software, CAD or the spreadsheet based on a visual inspection because the output bears a special font, a special look that makes it possible to identify the output as having been produced using the software, CAD or the spreadsheet.

See col. 6: 4 to col. 7: 10; col. 16: 25 to col. 19: 15;  
figs 5 and 6

As per claims 26, 33, 34 and 40, although Robertson discloses providing by the user a payment for (accessing) the (CAD) Tool, such as the IP core, however, he does not expressly teach providing a first payment and a second payment (one more payment) for the Tool (i.e.

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paying for the Tool based on a payment plan), wherein a request for the second (additional) payment is received when the user produces an output using the Tool and wherein the output bears a watermark (i.e. an identifier, a special font, a recognizable look, etc.) for identifying the output as having been produced by the Tool.

However, it is common practice in the art to sell a product or service to a user and to allow the user to pay for the product or service by providing one or more additional payments over a certain period of time, after receiving an initial payment from the user, based on a payment installment plan (payment schedule). For example, a user, purchasing a vehicle from a dealer, a computer from a store or an expensive software package from a vendor/developer, agrees to pay the balance due in one or more subsequent payments, upon receiving an initial payment from the user, in accordance with a payment installment plan (contract) negotiated between the user/buyer and the dealer, the store or the software developer.

Additionally, it is common practice in the art to watermark an output or an object, such as a dollar bill or a Software or a video delivered to a user, to thereby verify or guarantee the integrity of the dollar bill, Software or the video while preventing fraud.

#### “Official Notice”

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the Robertson’s system so as to allow a user to access a CAD tool to produce an output, upon receiving an initial payment from the user, and to pay the balance due in one or more subsequent payments based upon a payment installment play (contract) negotiated between the user and the CAD supplier through the portal site, wherein the output produced using the CAD bears a special signature/feature,



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trademark, appearance, special font, or special identifier or watermark identifying the output as one having been generated using the CAD, thereby enabling a user or an independent designer to have real-time access to the tools, such as CAD tools, he needs to complete a project without a large initial capital outlay or large up front payment (See col. 4: 48-61 of Robertson's) by negotiating via the portal site a payment installment plan or payment schedule with the supplier of a CAD tool, wherein the payment plan permits the user to defer payment or to pay the balance due in one or more subsequent payments in accordance with the payment schedule (contract) and after the user has used the tool to generate an output, which provides him with some income or cash flow.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,141,653A to Conklin discloses a multivariate negotiations engine for iterative bargaining which enables a sponsor to create and administer a community between participants such as buyers and sellers having similar interests; allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms, request sample quantities, and track activity; allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to negotiate multiple variables such as prices, terms, conditions etc., iteratively with a buyer. The

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system provides secure databases, search engines, and other tools for use by the sponsor, which enable the sponsor to define the terms of community participation, establish standards, help promote the visibility of participating companies, monitor activity, collect fees, and promote successes. All this is done through a multivariate negotiations engine system operated at the system provider's Internet site, thus requiring no additional software at the sponsors', or participant sellers', or buyer's sites. This also allows buyers and sellers to use and negotiate payment options and methods that are accepted internationally. The system maintains internal databases that contain the history of all transactions in each community, so that sponsors, buyers and sellers may retrieve appropriate records to document each stage of interaction and negotiation. Documents are created by the system during the negotiation process.

USP 6,269,467B1 to Chang discloses a method and apparatus for designing a circuit system, including selecting a plurality of pre-designed circuit blocks to be used to design the circuit system, collecting data reflecting the experience of the designer regarding the pre-designed circuit blocks, the designer's experience being adaptable to a processing method, accepting or rejecting a design of the circuit system in a manner based on the designer's experience data and acceptable degree of risk, upon acceptance, forming block specifications containing criteria and modified constraints for each of the circuit blocks, upon acceptance, forming block specifications for deploying the circuit blocks on a floor plan of a chip, as a system on a chip, in compliance with the criteria and modified constraints, and substantially without changing the selected circuit block and the processing method (see abstract).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally

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be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

09/24/06

**JDJ**

**Jean D. Janvier**

**Patent Examiner**

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JEAN D. JANVIER  
PRIMARY EXAMINER

